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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,456	08/02/2001	Dwip N. Banerjee	AUS920010503US1	5605

7590 10/27/2005

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EXAMINER

VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/920,456	Applicant(s) BANERJEE ET AL.	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☒ Claim(s) 22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it contains 250 words which exceeds the maximum allowable word threshold of 150 words.

Correction is required. See MPEP § 608.01(b).
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 22 and 23 make a reference to "said user selection information" when user selection information is not previously referenced in either claim 22 or 23 or a claim from which they

Art Unit: 3622

depend. The examiner suggests changing the term "said user selection information" to read "said user selection"

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 28 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The mere incorporation of data on a disk is considered non-functional descriptive material (See MPEP 2106(IV)(B)1(b).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by

A. Asthana, M. Cravatts and P. Krzyzanouski, (An indoor wireless system for

Art Unit: 3622

personalized shopping assistance, in: eds. L.-F. Cabrera and M.

Sattyanarayanan, *Workshop on Mobile Computing Systems and Applications*

(IEEE Computer Society Press, December 1994) pp. 69–74).

8. Claim 19: Asthana et al. discloses a customer processing device comprising:
 - a. A scanning means selectively operable to scan coded indicia (Col 1, paragraph 2).
 - b. That provides a scanned data output signal representative of said coded indicia means for transmitting said scanned data output signal to a server system (Col 8, lines 2-4)
 - c. Said server system being operable to transmit response information to said customer processing device in response to a receipt of said scanned data output signal (Col 8, lines 4-8)
 - d. A means for receiving said response information by said customer processing device (Col 8, lines 8-9)
 - e. A means for displaying said response information by said customer processing device (Col 8, lines 8-9).
9. Claim 20: Asthana et al discloses a customer processing device as set forth in claim 19 and further including means for enabling a user to make a user selection from said displayed response information.(Col 9, lines 8-13)

10. Claim 21: Asthana et al discloses a customer processing device as set forth in claim 20 wherein said means for transmitting is further selectively operable to transmit information related to said user selection to said server system. (Col 9, lines 8-13 and Col 5, lines 17-19)
11. Claim 22: Asthana et al disclose a customer processing device as set forth in claim 20 wherein said customer processing device further includes means for storing said user selection information. (Col 9, lines 8-17)
12. Claim 23: Asthana et al disclose a customer processing device as set forth in claim 22 wherein said customer processing device further includes means for selectively retrieving said user selection information. (Col 9, lines 13-17)
13. Claims 1-18 and 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (U.S. Patent Number 6,129,274).
14. Claim 1: Suzuki discloses a method for processing discounts to customers for products being offered to said customers, said method comprising:
 - a. Entering product information into a customer processing device, said product information being sufficient to identify a selected product. (Col 8, lines 59-65)
 - b. Transmitting said product information from said customer processing device to a server, said server being responsive to a receipt of said product information for determining discount information, said discount

Art Unit: 3622

information being related to discounts which are available for said selected product. (Col 9, lines 8-13 and Col 6, lines 15-21)

c. Transmitting said discount information from said server to said customer processing device. (Col 9, lines 13-17)

15. Claim 2: Suzuki discloses a method as set forth in claim 1 wherein said product information is entered into said customer processing device manually by said customer. (Col 8 line 67 and Col 9 line 1)

16. Claim 3: Suzuki discloses a method as set forth in claim 2 where said product information is entered by said customer at a discount kiosk station located in a store in which said products may be acquired by said customer. (Col 9, lines 18-23)

17. Claim 4: Suzuki discloses a method as set forth in claim 1 wherein said product information is represented by machine readable coded indicia, said machine readable coded indicia being placed proximate to said selected product, said entering being accomplished by scanning said machine readable coded indicia by said customer processing device (Col 9, lines 18-23). A more detailed description of the sited hand-held terminal can be found in Ogasawara (U.S. Patent Number: 6,386,450 Column 2, lines 31-46) and includes a portable scanner.

18. Claim 5: Suzuki discloses a method as set forth in claim 1 wherein said customer processing device is a wireless device. (Col. 9, lines 51-55)

19. Claim 6: Suzuki discloses a method as set forth in claim 1 and further including: displaying said discount information on a display screen of said customer processing device. (Col 8, lines 65-67 and Col 9, lines 1-4)
20. Claim 7: Suzuki discloses a method as set forth in claim 6 and further including: using said customer processing device to choose a selected discount from said discount information. (Col 7, lines 44-49)
21. Claim 8: Suzuki discloses a method as set forth in claim 6 wherein said discount information includes a plurality of different discounts available for said selected product, said method further including: using said customer processing device to choose a selected discount from said plurality of different discounts. (Col 7, lines 21-28 and Col 13 lines 59-62)
22. Claim 9: Suzuki discloses a method as set forth in claim 7 and further including: saving said selected discount information in a memory. (Col 11, lines 42-49)
23. Claim 10: Suzuki discloses a method as set forth in claim 9 wherein said selected discount information is transmitted to a local server, said selected discount information being saved in memory in said local server. (Col 9, lines 8-16)
24. Claim 11: Suzuki discloses a method as set forth in claim 9 wherein said selected discount information is saved in a memory within said customer processing device. (Col 11, lines 42-49)

25. Claim 12: Suzuki discloses a method as set forth in claim 9 and further including: associating customer identification information with said selected discount information in said memory. (Col 7, lines 20-28)
26. Claim 13: Suzuki discloses a method as set forth in claim 12 and further including: providing customer identifying information for identifying said customer at a checkout terminal; and retrieving said selected product information and said discount information associated with said customer in response to receiving said customer identifying information at said checkout terminal. (Col 7, lines 58-67)
27. Claim 14: Suzuki discloses a method as set forth in claim 13 and further including deducting selected discounts obtained from said selected discount information from charges otherwise applicable for said selected products at said checkout terminal. (Col 8, lines 20-24)
28. Claim 15: Suzuki discloses a method as set forth in claim 14 and further including updating databases associated with said selected products, said updating being initiated at said checkout terminal. (Col 8, lines 2-5)
29. Claim 16: Suzuki discloses a method as set forth in claim 1 wherein said products are offered for sale to said customers. (Col 5, lines 62-65)
30. Claim 17: Suzuki discloses method as set forth in claim 1 wherein said products are offered for license to said customers. (Col 5, lines 62-65). Please note that chain stores issue fishing and hunting licenses.

Art Unit: 3622

31. Claim 18: Suzuki discloses a method as set forth in claim 1 wherein said products are offered for lease to said customers. (Col 5, lines 62-65). Please note that chain stores lease equipment such as carpet cleaning machines.
32. Claim 24: Suzuki discloses a computer terminal in a store environment wherein products are offered to customers, said computer terminal comprising:
- a. Input means by which said customers are enabled to input product information related to a particular product into a computerized discount system coupled to said computer terminal. (Col 8, lines 59-65 and Col 6, lines 15-21)
 - b. Transmitting means for transmitting said product information from said computer terminal to said computerized discount system. (Col 9, lines 8-13 and Col 6, lines 15-21)
 - c. Said computerized discount system being operable in response to a receipt of said product information from said computer terminal for providing discount information applicable to said product. (Col 6, lines 15-21)
 - d. Means for displaying said discount information at said computer terminal. (Col 9 lines 28-30)
33. Claim 25: Suzuki discloses a computer terminal as set forth in claim 24 wherein said input means is selectively operable for enabling a user to select a preferred discount from said displayed discount information. (Col 13, lines 59-67)

34. Claim 26: Suzuki discloses a computer terminal as set forth in claim 25 wherein said transmitting means is further selectively operable to transmit said preferred discount to a local server system. (Col 9, lines 8-17)
35. Claim 27: Suzuki discloses a computer terminal as set forth in claim 26 wherein said preferred discount is stored at said local server system. (Col 9, lines 8-17)
36. Claim 28: Suzuki discloses a memory device containing coded indicia,
- a. Said coded indicia being selectively accessible for providing program signals for processing discounts to customers for products being offered to said customers (Col 7, lines 20-24)
 - b. Said program signals being selectively operable for enabling: entering product information into a customer processing device. (Col 8, lines 59-61)
 - c. Said product information being sufficient to identify a selected product; transmitting said product information from said customer processing device to a server. (Col 8, lines 62-65)
 - d. Said server being responsive to a receipt of said product information for determining discount information. (Col 13, lines 51-56)
 - e. Said discount information being related to discounts which are available for said selected product. (Col 13, lines 59-62)

f. Transmitting said discount information from said server to said customer processing device. (Col 13, lines 59-62)

37. Claim 29: Suzuki discloses a computer system arranged for processing discounts to customers for products being offered to said customers, said computer system comprising:

a. Means for storing a searchable product discount database. (Col 13, lines 6-9)

b. Means for receiving information identifying a particular product by a customer. (Col 8, lines 62-65);

c. Means for searching said product discount database to determine discount information applicable to said particular product. (Col 13, lines 6-9)

d. Means for transmitting said discount information for display on a customer device by which said customer may select a preferred discount from said discount information. (Col 13, lines 51-56 & lines 59-62)

e. Means for receiving information identifying said preferred discount from said customer device. (Col 12, lines 4-7)

f. Means responsive to a request received from a checkout terminal for transmitting said preferred discount information to said checkout terminal. (Col 7 lines 62-67 and Col 8 lines 1-4)

Claim Rejections - 35 USC § 103

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

39. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,129,274) in view of Fajkowski (U.S. Patent Number: 5,905,246).

40. Claim 30: Suzuki discloses a computer system arranged for processing discounts to customers for products being offered to said customers discount processing system as in claim 29, but does not specifically refer to the necessary component of storing the data in a format that provides a means for assigning charges to appropriate store and manufacturer accounts for the proper allocation of said preferred discount. However, Fajkowski discloses a similar apparatus for coupon management and redemption that specifically includes a redemption report developed from data stored on a server that is used to assign charges to proper store and manufacturer accounts for the proper allocation of said preferred discount (Col 22, lines 11-23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such functionality in the computer system described in Suzuki, so as to

obtain manufacturer reimbursements and other accounting functions necessary upon coupon redemption.

Conclusion

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ogasawara (U.S. Patent Number: 6,123,259), Ruppert et al. (U.S. Patent Number: 5,424,524), Counts (U.S. Patent Number: 5,192,854) and Valencia et al (U.S. Patent Number: 5380991)
42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.
43. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

44. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jvb


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